

REMARKS

Applicant would like to express appreciation to the Examiner for the detailed Official Action provided. Upon entry of the present paper, claims 6, 9 and 11 will have been amended, claims 7 and 12 will have been canceled and claims 14-15 will have been added. Claims 6, 8-11 and 13-15 pending in the present application. Applicant notes claim 9 has been amended solely to depend from a non-canceled claim. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection in the present application. Such action is respectfully requested and is now believed to be appropriate.

The Examiner has rejected claims 6, 8 and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,794,609 to MART, finding that this reference teaches all limitations of these claims. Applicant respectfully traverses the Examiner's rejection, and submit that the references of record are is markedly different from the present claimed invention.

With respect to the Examiner's rejection of independent claims 6 and 11, without agreeing to the propriety of the Examiner's rejections and solely in order to expedite the patent application process, Applicant has generally included the limitations of dependent claim 7 into independent claim 6, and has generally included the limitations of dependent claim 12 into independent claim 11 (claims 7 and 12 having been rejected under 35 U.S.C. § 103(a) as being unpatentable over MART in view of U.S. Patent No. 5,210,405 to TOYODA- *see* discussion *infra*), and has canceled claims 7 and 12 without prejudice or disclaimer. Such amendments to claims 6 and 11 have been made solely in order to advance prosecution of the present application and without agreeing to the propriety of the Examiner's rejections.

With respect to the rejection of dependent claims 7 and 12, the Examiner has correctly asserted that MART does not disclose the grip and contact part being connected by a pivot connection. However, the Examiner has asserted that TOYODA discloses an “input device comprising a ball rotatable [*sic*, rotatably] supported by an end of a pen-type elongate handle” and concludes that it would have been obvious to include the rotatable ball of TOYODA in to the system of MART. Applicant respectfully traverses the Examiner’s assertion. Specifically, Applicant notes that MART is directed to a prosthetic finger having a pad 108 which contacts a touchscreen, and Applicant respectfully submits that one skilled in the art would not combine MART and TOYODA and arrive at the invention of the independent claims. Rather, any proper combination of MART and TOYODA would motivate one of skill in the art to install the ball 6 of TOYODA into the device of MART, such that the combination would no longer have a planar pad contact face, thereby teaching away from the claimed pivoting planar pad contact face.

Applicant further submits that the applied references further fail to teach or disclose at least the claimed electrically-conductive outer grip configured to electrically contact a hand of a user (as generally claimed in independent claim 6 (and new independent claim 14), or at least the establishing electrical contact between a user and the electrically-conductive grip, as generally claimed in independent claim 11. Rather, TOYODA (which the Examiner has relied on for the teaching of the claimed electrically-conductive grip) appears to have an *insulating grip* (handle 2, for insulating the user’s hand from shock by the electrical components within the grip portion) and not the electrically-conductive grip of the independent claims.

Applicant notes that in the present invention, to provide sufficient capacitance change, the grip must be made from metal or other conductive material to charge the input element by the charge of

a user's (human) body. If the grip is electrically insulated from the human body (as is the case with TOYODA), an input mechanism cannot cause capacitance change on the touch-pad. Further, if the grip is electrically insulated (by, e.g., plastic or rubber), and the operator grips the grip portion through the plastic or rubber grip, the capacitance of the input element cannot be changed, because the charge transfer between the grip portion and the human body cannot occur. Thus, it is respectfully submitted that the applied references fail to disclose the invention of at least independent claims 6 and 11 (and new claim 14).

Applicant further notes that the claimed electrically-conductive grip feature of the amended claims has been further clarified to render what was already implied in these claims (*i.e.*, that there is electrical contact between the user and the grip), without agreeing to the propriety of the Examiner's rejections and solely in order to expedite the patent application process.

With respect to the Examiner's rejection of dependent claims 8, 9, 10 and 13, since these claims (including new dependent claim 15) are dependent from one of independent claims 6 and 11 (and new independent claim 14), which are allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, these claims recite additional features which further define the present invention over the references of record.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied references fail to disclose each and every element recited in independent claims 6 and 11 (and new claim 14), these claims, and the claims dependent therefrom, are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejections under 35 U.S.C. § 102.

Thus, Applicant respectfully submits that each and every pending claim of the present application meets the requirements for Patentability at least under 35 U.S.C. §§102 and 103, and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.

SUMMARY AND CONCLUSION

In view of the fact that none of the art of record, whether considered alone, or in any proper combination thereof, discloses the present invention, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability (*e.g.*, for cosmetic purposes), and no estoppel should be deemed to attach thereto.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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